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LACASSE & ASSOCIATES, LLC
1725 DUKE STREET
SUITE 650
ALEXANDRIA, VA 22314

EXAMINER

GART, MATTHEW S

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 13

Application Number: 09/500,439
Filing Date: February 09, 2000
Appellant(s): RUVOLO ET AL.

MAILED

JUL 02 2003

Ramraj Soundararajan
For Appellant

GROUP 3600

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6 May 2003

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct. The Examiner notes that the Summary of the Invention contains arguments related to the prior art, which will be addressed below.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1-37 stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) ClaimsAppealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

Xcontact, <http://www.chez.com/svs/XcontactUS.html>, February 03, 1999

5,831,611

Kennedy et al.

11-1998

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims. The ground(s) for rejection are reproduced below from the final Office Action and are provided here for the convenience of both Appellant and The Board of Patent Appeals:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 9-17, 21-28, and 33-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Xcontact in view of Official Notice.

Referring to claims 1, 14, and 26. Xcontact discloses a computer-based method, system, and article of manufacture equivalent to a computer-based method, system, and article of manufacturer of dynamically presenting potential contacts to a user comprising the following:

- Retaining user preferences in computer storage (at least page 4, *sort functions*);
- Retaining a list of possible contacts (at least page 4, *contact list*);
- A contact list stored in computer storage, said contact list comprising at least identifying information and available images of said contacts (at least page 4, *browser sample*);
- A list comprising at least identifying information of said contacts (at least page 4, *browser sample*);
- Automatically searching said list of possible contacts to select a potential contact based on said user preferences (at least page 4, *powerful search functions*);
- Retaining potential contacts selected during said search (at least page 4, *last search is saved*);
- Displaying to the user an available image or other identifying information of a potential contact (at least page 4, *browser sample*).
- A manual request unit (at least page 4, *powerful search functions*);
- A time-based request unit providing an invocation for time-based automatic searching (at least page 3, *alarms*); and
- A request processor, said processor detecting an invocation output from said manual request unit or said time-based request unit and initiating said search module to select one or more possible contacts, and wherein said selected candidates are stored in computer storage and processed to display, by said display module, said selected contact image or information to the user (at least page 4, *last search is saved, so the Contact List window will be displayed automatically...*).

Xcontact does not expressly disclose automatically searching a list of possible contacts. Examiner takes Official Notice that it was known at the time of the invention that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). For example, simply automating the step of searching a list for possible contacts based upon the information from a user gives you just what you would expect from the manual step as shown in Xcontact. In other words there is no enhancement found in the claimed step. The claimed searching step only provides automating the manual activity. The end result is the same as compared to the manual method. It would have been obvious to a person of ordinary skill in the art at the time of the invention to automate searching a list for possible contacts because this would allow a fast indexed and global search.

Referring to claims 2 and 15. Xcontact further discloses user preferences wherein said user preferences comprise either preferences input by the user (at least page 4, *browser sample*) or pre-selected default preferences (at least page 4, *sort functions*).

Referring to claims 3, 9, 16, 21, 27, and 33. Xcontact in view of Official Notice discloses a computer-based method, system, and article of manufacture according to claims 1, 14, and 26 as indicated supra. Xcontact further discloses user preferences wherein said user preferences comprise any of:

- Professional or personal contact (at least page 4, *browser sample*),
- Automatic preference on initiating the searching step (at least page 3, *alarms* and page 4, *sort functions*).

Xcontact does not expressly disclose a computer-based method, system, and article of manufacturer wherein said search step is repeated until a maximum number of candidates for selection has been achieved. Examiner takes official notice that a search step that is repeated until a maximum number of search results are achieved was art recognized at the time of the invention. It would have been obvious for a maximum number of search results to be achieved during a search step in order to provide the user with an efficient and accurate searching means. Accordingly, it would have been obvious to one of ordinary skill in the art to modify the system of Xcontact to include a search step that is repeated until a maximum number of search results are achieved.

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Referring to claims 4, 17, and 28. Xcontact further discloses a list of contacts comprising any of: Name, organization, work address, home address, telephone numbers, pager numbers, cellular numbers, e-mail address, personal or professional identifiers, special dates, and contact dates (at least page 4, *browser sample*).

Referring to claims 10, 22, and 34. Xcontact further discloses a computer-based method and system wherein displaying step further comprises insertion of said available image or identifying information into a GUI (at least page 4, *browser sample*).

Referring to claims 11, 23, and 35. Xcontact further discloses a computer-based method and system wherein a GUI comprises an electronic organizer (at least page 2, *browser sample*).

Referring to claims 12-13, 24-25, and 36-37. Xcontact further discloses a method and system wherein said method and system may be implemented locally or remotely on one or more computer based systems, across networks, LANs, WANs, cellular, Internet, Web-based networks or existing communication mediums (at least page 3, *compatible with your WEB Browser and E-mailer*).

Claims 5-8, 18-20 and 29-32 are rejected under 35 U.S.C. 103(a) as being anticipated by Xcontact U.S. Patent No. 5,737,726, in view of Official Notice, in further view of Kennedy et al. U.S. Patent No. 5,831,611.

Referring to claim 5. Xcontact in view of Official Notice discloses a computer-based method according to claim 1 as indicated supra. Xcontact in view of Official Notice does not expressly disclose a searching step wherein said searching step is initiated automatically by a time-based reference in the user preferences. Kennedy et al. discloses a searching step wherein said searching step is initiated automatically by a time-based reference in the user preferences (at least column 2, lines 46-58 and claims 12-13). Although this form is not found in Xcontact, it would have been obvious to provide the method of Xcontact to include the limitations as taught by Kennedy in order for an individual to establish, develop, and maintain relationships with customers and vendors. Moreover, to have modified the method of Xcontact to have included the search step components would have been obvious to the skilled artisan because the inclusions of such components would have been an obvious matter of design choice in light of the method already disclosed by Xcontact. Such modifications would not have otherwise affected the method of Xcontact and would merely represent one of numerous steps that the skilled artisan would have found obvious because the successful performance of a business relies upon establishing and then adhering to a set of contact communication protocols (at least column 1, lines 15-27) as disclosed by Kennedy et al. Additionally applicant has not persuasively demonstrated the criticality of providing this step versus the step disclosed by Xcontact.

Referring to claims 6, 18, and 30. Xcontact in view of Official Notice discloses a computer-based method and a computer media product according to claims 3, 14, and 29 as indicated supra. Xcontact does not expressly disclose a computer-based method and a computer media product wherein a time-based reference comprises any of: frequency of contact, time between contacts or calendar-based contact. Kennedy et al. discloses a computer-based method wherein a time-based reference comprises any of: frequency of contact, time between contacts or calendar-based contact (at least column 2, lines 13-58). Although this form is not found in Xcontact, it would have been obvious to provide the method of Xcontact to include the limitations as taught by Kennedy in order for an individual to establish, develop, and maintain relationships with customers and vendors. Moreover, to have modified the method of Xcontact to have included the time-based reference components would have been obvious to the skilled artisan because the inclusions of such components would have been an obvious matter of design choice in light of the method already disclosed by Xcontact. Such modifications would not have otherwise affected the method of Xcontact and would merely represent one of numerous steps that the skilled artisan would have found obvious because the successful performance of a business relies upon establishing and then adhering to a set of contact communication protocols (at least column 1, lines 15-27) as disclosed by Kennedy et al. Additionally applicant has not persuasively demonstrated the criticality of providing this step versus the step disclosed by Xcontact.

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Referring to claims 7, 19, and 29. Xcontact in view of Official Notice discloses a computer-based system and an article of manufacture for dynamically selecting possible contacts according to claims 5, 16, and 26 as indicated supra. Xcontact in view of Official Notice does not expressly disclose a search module comprising, comparing applicable time-based references stored in said user preferences with said timer module, and upon a positive comparison, initiating said search. Kennedy et al. discloses a search module comprising, comparing applicable time-based references stored in said user preferences with said timer module, and upon a positive comparison, initiating said search (at least column 1, lines 38-59). Although this form is not found in Xcontact, it would have been obvious to provide the method of Xcontact to include the limitations as taught by Kennedy in order for an individual to establish, develop, and maintain relationships with customers and vendors. Moreover, to have modified the method of Xcontact to have included the time-based reference components would have been obvious to the skilled artisan because the inclusions of such components would have been an obvious matter of design choice in light of the method already disclosed by Xcontact. Such modifications would not have otherwise affected the method of Xcontact and would merely represent one of numerous steps that the skilled artisan would have found obvious because the successful performance of a business relies upon establishing and then adhering to a set of contact communication protocols (at least column 1, lines 15-27) as disclosed by Kennedy et al. Additionally applicant has not persuasively demonstrated the criticality of providing this step versus the step disclosed by Xcontact.

Referring to claims 8, 20, and 32. Xcontact in view of Official Notice discloses a computer-based method and a computer-based system according to claims 1, 14, and 26 as indicated supra. Xcontact in view of Official Notice does not expressly disclose a computer-based system and a computer-based method wherein selection of a potential contact in said search step is either random or based on a select algorithm. Kennedy et al. discloses a computer-based system and a computer-based method wherein selection of a potential contact in said search step is either random or based on a select algorithm (at least column 1, line 15 to column 2, line 10). Although this form is not found in Xcontact, it would have been obvious to provide the method of Xcontact to include the limitations as taught by Kennedy in order for an individual to establish, develop, and maintain relationships with customers and vendors. Moreover, to have modified the method of Xcontact to have included the search step components would have been obvious to the skilled artisan because the inclusions of such components would have been an obvious matter of design choice in light of the method already disclosed by Xcontact. Such modifications would not have otherwise affected the method of Xcontact and would merely represent one of numerous steps that the skilled artisan would have found obvious because the successful performance of a business relies upon establishing and then adhering to a set of contact communication protocols (at least column 1, lines 15-27) as disclosed by Kennedy et al. Additionally applicant has not persuasively demonstrated the criticality of providing this step versus the step disclosed by Xcontact.

Referring to claim 31. Xcontact in view of Official Notice discloses an article of manufacture comprising a computer media product implementing a process for selecting and presenting to a user possible candidates for contact according to claim 31 as indicated supra. Xcontact in view of Official Notice does not expressly disclose a search comprising, comparing applicable time-based references stored in said user preferences with a timer function, and upon a positive comparison, initiating said search. Kennedy et al. discloses a search comprising, comparing applicable time-based references stored in said user preferences with a timer function, and upon a positive comparison, initiating said search (at least column 1, lines 38-59). Although this form is not found in Xcontact, it would have been obvious to provide the method of Xcontact to include the limitations as taught by Kennedy in order for an individual to establish, develop, and maintain relationships with customers and vendors. Moreover, to have modified the method of Xcontact to have included the search step components would have been obvious to the skilled artisan because the inclusions of such components would have been an obvious matter of design choice in light of the method already disclosed by Xcontact. Such modifications would not have otherwise affected the method of Xcontact and would merely represent one of numerous steps that the skilled artisan would have found obvious because the successful performance of a

business relies upon establishing and then adhering to a set of contact communication protocols (at least column 1, lines 15-27) as disclosed by Kennedy et al. Additionally applicant has not persuasively demonstrated the criticality of providing this step versus the step disclosed by Xcontact.

(11) Response to Argument

Referring to Independent Claims 1 and 26

The Appellant argues at page 11 of the Brief, that "Xcontact does not, either explicitly or implicitly, teach or suggest a system or method for using the contact information stored within to intelligently and automatically remind the user to keep in communication with specific contacts over time, based on pre-stored preferences."

The Examiner notes that Xcontact teaches a system and method, which can save "any information about your contacts." Xcontact can then provide a fast indexed and global search of those contacts. Xcontact can further provide the user with alarms that can remind the user of particular important events.

Xcontact further provides a Sort function, whereby a user can search by various user specified data, this user specified data is based on a user's preference. The user chooses which data to sort and search, and then a sort or search function is performed.

The Appellant argues that Xcontact does not "...intelligently and automatically remind the user to keep in communication with specific contacts over time."

The Examiner notes, all of the independent claims (1, 14 and 26) of the instant invention refer to automatically searching possible contacts. The independent claims do not reference automatically reminding a user. Automatically searching refers to the automatic data mining of a data storage device, and not necessarily automatically presenting a result that acts to remind the user of a specific event. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The Appellant argues that the "... sort function as used in Xcontact does not refer to preferences, but instead refers to various fields, such as First Name, Name, or Company. By contrast, the term 'Preference', as used in applicants' specification and claims define: the type of contact, the time-based frequency of contact in an automatic invocation, the type of selection algorithm, etc."

The Examiner notes, that neither independent claim 1 nor claim 26 defines "Preferences" as a type of contact, as time-based or as algorithm based. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The Appellant argues that Xcontact does not disclose a "time-based request unit providing an invocation for time-based automatic searching."

The Examiner notes that the feature upon which applicant relies are not commensurate with the scope of independent claim(s) 1 and 26. These claims were given the broadest reasonable interpretation in an effort to reduce the

possibility that these claims, once issued, will be interpreted more broadly than is justified. See *In re Prater*, 415 F2.d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969).

Referring to Independent Claim 14

The Appellant argues that Xcontact does not disclose a “time-based request unit providing an invocation for time-based automatic searching.”

The Examiner notes, Xcontact does disclose the use of Alarms to remind a user of a particular important event. An alarm by definition is a time-based reminder and is used to automatically initiate an event. Furthermore as applied in subsequent dependent claims, Kennedy discloses a method wherein a scheduled event includes the step of prompting a user for intervention (Kennedy: claim 13). Kennedy further teaches an appointment calendar and the scheduling of future appointments and automatic follow-up reminders (Kennedy: column 1, lines 49-59).

Referring to Subsequent Dependent Claims

The Appellant argues that the “... sort function as used in Xcontact does not refer to preferences, but instead refers to various fields, such as First Name, Name, or Company. By contrast, the term ‘Preference’, as used in applicants’ specification and claims define: the type of contact, the time-based frequency of contact in an automatic invocation, the type of selection algorithm, etc.”

The Examiner notes, this limitation is addressed in the rejection of subsequent dependent claims (i.e. claims 5-8, 18-20 and 29-32) whereby Xcontact in view of Kennedy and Official Notice obviates those particular claims. Kennedy provides a communication management system, which automatically applies a communication protocol to a set of database entries representing a wide and diverse variety of business contacts in order to generate and execute a set of scheduled events (Kennedy: column 2, lines 17-21). Kennedy further teaches a system that provides programming tools which enable businesses to quickly and easily develop contact communication protocols which are then applied generally to a database of business contacts (Kennedy: column 1, line 60 to column 2, line 9).

The Appellant on page 15 refers to Cameron U.S. Patent No. 5,737,726 and uses Cameron U.S. Patent No. 5,737,726 to present arguments.

The Examiner notes that the Final office action never used Cameron U.S. Patent No. 5,737,726 as a reference. There was a single typographical error on page 5, which mentioned, "U.S. Patent No. 5,737,726," but the duration of the Final office action and the Notice of Reference Cited clearly establishes the use of only Xcontact and Kennedy U.S. Patent No. 5,831,611 as references. Cameron was used as the primary reference in the First office action non-final, and was subsequently removed in the Examiner's Second office action non-final and confirmed via a telephonic interview with the Appellant.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

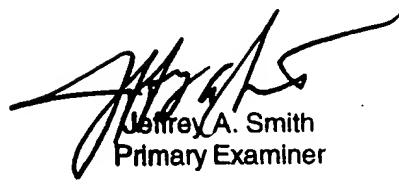
MSG
June 24, 2003

Conferees


Matthew S Gart
Patent Examiner
Technology Center 3600


Jeffrey A. Smith
Primary Examiner
Technology Center 3600


Robert Weinhardt
Primary Examiner
Technology Center 3600


Jeffrey A. Smith
Primary Examiner

LACASSE & ASSOCIATES, LLC
1725 DUKE STREET
SUITE 650
ALEXANDRIA, VA 22314